

REMARKS

Claims 9-14, 24-28, 35, and 39-59 are pending in this Office Action. Applicants have amended claim 9 and canceled claim 60 without prejudice. Claims 10-14, 24-28, 35, 39-50, and 52-59 are withdrawn.

Finality of the Office Action

Applicants respectfully request the Examiner to withdraw the finality of this Office Action. According to MPEP § 706.07(a)

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicants submit that the present (second) Office Action was improperly made final, because it was not necessitated by the applicants' amendments¹ nor was it necessitated by an IDS submitted by the applicants. Rather, as stated in the Office Action (page 2), "The Examiner would like to state that after the interview updated searches provided prior art that reads on other species of the genus of claimed polypeptides" (emphasis added). Because these searches were newly executed by the Examiner and not necessitated by the applicants' amendments in their previous Reply to Office Action (dated May 4, 2005), and because applicants overcame all of the rejections in the previous Office Action (dated February 9, 2005), applicants submit that the present Office Action was improperly made final.

Applicants reserve the right to petition for the reconsideration and withdrawal of the finality of this Office Action.

¹ The inclusion of part (M) to claim 9 in the Amendment dated May 4, 2005 narrowed, rather than broadened, the scope of claim 9.

35 U.S.C. § 102

The Office Action alleges that a sequence disclosed in Figures 1b and 7 of Han et al. (*Virology* **251**:253-263 (1998)) anticipates a species of SEQ ID NO:10. Applicants note that this rejection pertains to part (M) of claim 9, and have canceled part (M) of claim 9. Applicants respectfully point out that this rejection does not pertain to part (J) of claim 9, as it was amended in the previous Reply to Office Action (dated May 4, 2005):

Han et al. teaches the sequence: Cys-**Thr**-Val-Thr-Lys-Thr-Gln-Gly-Cys

The consensus sequence of part (J) is: Cys- **X₂** - X₃ - X₄ - X₅ - X₆ - X₇ - X₈ -Cys

The allowed substituents for X₂ in claim 9, part (J) are Asn or Asp. Thr is not one of the possible substituents recited in the claim. Thus, the sequence in Han et al. does not teach the sequence recited in claim 9, part (J). Because applicants have canceled part (M), they respectfully request that this rejection be withdrawn.

35 U.S.C. § 112, Second Paragraph

The Office Action (page 3) alleges that claims 9, 51, and 60 are indefinite due to the addition of consensus sequence M to claim 9. Without conceding to the correctness of this allegation, applicants have amended claim 9 to cancel the part of that claim that recites consensus sequence M. Thus, applicants respectfully request that this rejection be withdrawn.

Claim Rejoinder

Applicants respectfully request rejoinder of all of the withdrawn claims upon allowance of the presently-examined claims.

Claims 10-12, 14, 24-26, 39, 40, 42-49, 51, 52, and 57-60 (applicants have canceled claim 60) were pending in the previous Office Action (dated February 9, 2005). The present Office Action has withdrawn these claims. Applicants respectfully submit that the present Office Action has improperly withdrawn these claims. As stated in the Office Action dated February 9, 2005 (page 2), "a search of the Markush-type claims was extended for claims 9-10." First, applicants submit that it was improper to withdraw claims 10-12, 14, 24-26, 39, 40, 42-49, 51, 52, and 57-60, because the Examiner has apparently already searched these claims.

Second, in applicants' Response to Restriction Requirement dated November 5, 2004, applicants elected (with traverse) SEQ ID NO:163 as their species election. Thus, applicants submit that it was improper for the Office Action to withdraw claims that read on the elected species (e.g., claims 9, 10, 11, 14, 39, 40, 41, 42, 43, 44, 46, 47, 48, 49, and 50). For example, claim 47 refers to SEQ ID NO:163. Applicants request that, at a minimum, these claims be rejoined to the presently-examined claims and that withdrawn claims 25, 26, 28, 35, 55, 56, which are directed to methods of using the elected species and polynucleotides encoding the elected species, be rejoined upon allowance of the claims drawn to the elected species.


CONCLUSION

Applicants have amended claim 9 and canceled claim 60. In light of these amendments, applicants respectfully submit that the rejections to claims 9 and 51 have been overcome and submit that these claims are in condition for allowance. In addition, applicants request that the finality of the present Office Action be withdrawn and that the claims withdrawn by the Office be rejoined.

No fees are believed due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 24 Oct 2005



Ramon K. Tabtiang
Reg. No. 55,658

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906